

35 U.S.C. §103(a) as being unpatentable over *Walz* (U.S. Patent No. 5,664,725) in view of *Popat et al.* (U.S. Patent No. 6,001,209).

By the present response, Applicant submits that the remarks and arguments below overcome the rejections by the Patent Office and places the application in condition for allowance.

With respect to the rejection of Claims 1-15 under 35 U.S.C. §103(a) as being unpatentable over *Petkovsek* in view of *Schwan et al.*, Applicant submits that this rejection is improper in view of Claims 1 and 13 as previously presented and for the reasons that follow.

More specifically, in the Office Action, the Patent Office alleges:

Petkovsek discloses in Figures 1, 2 and 6, a mailing assembly comprising a backing sheet (11), first and second mailing forms (10a and 10b) removably attached to the backing sheet by an adhesive (Col. 6, lines 21-25) and separable by a tear line (60) wherein the forms include a first return postcard (18) integrally formed with a designator section (20, 24A and 26) indicative of a special service (Col. 4, lines 10-14 and 29-31), having a machine readable code (24 for tracking the mailpiece), an identifying number (26A), an area for receiving instructions (20), and being distinctly colored (Col. 4, lines 40-41) and contained within the first exterior sides (right of perforated 29a,

and left of perforated line 33a) that defines the postcard.

The Patent Office admits that *Petkovsek* does not disclose a first designator section having a color corresponding to one of a plurality of special services, wherein the color is different for each one of the special services.

Additionally, the Patent Office alleges:

Schwan et al. discloses in Fig. 3, a record in the form of a label assembly (Col. 1, lines 10 and 11; and Col. 7, lines 14-16) having selected portions for forming areas of a plurality of different colors, wherein the label can be used for mailing labels in which different colors are activated to designate the method (special services) of shipment.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify *Petkovsek's* label to include a label having designated areas, wherein each area has a color corresponding to a shipment method (special services) as taught by *Schwan et al.* for the purpose of providing a means of emphasizing different categories of information on a label assembly.

Independent Claim 1 of the present invention requires a special service mailing assembly with a backing sheet and a first mailing form removably attached to the backing sheet by an adhesive. Additionally, the first mailing form has a first return postcard integrally formed with a first designator section contained within first exterior sides that define the first return postcard. Further, the first designator section

has an area to denote the type of special service for which the assembly is implemented and a tracking area for tracking the mailpiece. Still further, the first designator section has a color corresponding to one of a plurality of special services for delivery of a mailpiece wherein the color is different for each one of the plurality of special services.

Contrary to the assertion made by the Patent Office, *Petkovsek* merely teaches a mailing assembly formed from a single sheet to provide a label and a return postcard for use in mailing an item requiring special services. Additionally, *Schwan et al.* merely teach a sheet containing surface coatings of selected color formers and color developers which, when subjected to heat or pressure, combine to form different colored areas on the sheet. Further, *Schwan et al.* merely teach a business record in which different selected areas may be activated to form colored areas.

Clearly, neither *Petkovsek* nor *Schwan et al.*, taken singly or in combination, teach or suggest a special service mailing assembly having a designator section which has an area to denote the type of special service for which the assembly is implemented as required by Claim 1. Additionally, neither *Petkovsek* nor *Schwan et al.*, taken singly or in combination, teach or suggest a special service mailing assembly having a first designator section which has a color corresponding to

one of the plurality of special services for delivery of a mailpiece as required by Claim 1. Moreover, neither *Petkovsek* nor *Schwan et al.*, taken singly or in combination, teach or suggest a special service mailing assembly having a first designator section which has a color which is different for each one of the plurality of special services as required by Claim 1. Therefore, the rejection of Claim 1 under 35 U.S.C. §103(a) is improper and should be withdrawn. Notice to that effect is requested.

Independent Claim 13 of the present invention requires a method for preparing a mailpiece for delivery by a special service. The method has the step of providing a first return postcard having exterior sides and a first special designation section completely within exterior sides of the first return postcard. Additionally, Claim 13 requires the first special designation section to have an area for receiving instructions regarding the delivery, type of special service and an identifying number of a mailpiece by the special service. Moreover, Claim 13 requires the first special designation section to be located completely within the exterior sides that define the first postcard.

Furthermore, neither *Petkovsek* nor *Schwan et al.*, taken singly or in combination, teach or suggest a method for preparing a mailpiece for delivery by a special service having

the step of providing a first mailing form including a first return postcard removably attached to the backing sheet wherein the first return postcard is integrally formed with a first special service designation section as required by Claim 13. Moreover, neither *Petkovsek* nor *Schwan et al.*, taken singly or in combination, teach or suggest a method for preparing a mailpiece for delivery by a special service having a designation section which has an area for receiving instructions regarding the delivery, type of special service and an identifying number of the mailpiece by the special service as required by Claim 13. Additionally, neither *Petkovsek* nor *Schwan et al.*, taken singly or in combination, teach or suggest a method for preparing a mailpiece for delivery by a special service wherein the first special designation section is completely within exterior sides that define the first postcard as required by Claim 13. Contrary to the assertion of the Patent Office, *Petkovsek* merely teaches a return receipt postcard having a set of instructions for the sender, addressee section and a document control number bard code. Therefore, the rejection of Claim 13 under 35 U.S.C. §103(a) is improper and should be withdrawn. Notice to that effect is requested.

Moreover, with respect to the rejection of Claims 1-15 under 35 U.S.C. §103(a), one of ordinary skill in the art

would never have been motivated to modify *Petkovsek* with *Schwan et al.* in the manner suggested by the Patent Office in formulating the rejection of the claims under 35 U.S.C. §103(a). It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's mailing assembly and method, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of *Petkovsek* and *Schwan et al.* in mind, as enumerated above, no reason or

suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to modify *Petkovsek* with *Schwan et al.* to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

Accordingly, the rejection of Claims 1-15 under 35 U.S.C. §103, in view of *Petkovsek* and further in view of *Schwan et al.*, is improper and should be withdrawn. Notice to that effect is requested.

With respect to the assertion of the Patent Office that the label of *Petkovsek* is capable of denoting a special service that includes registered mail, certified mail, COD, return receipt for merchandise, Applicant asserts that the special service mailing assembly as specifically defined in Claim 1 has novel structural differences and is patentably distinct from the label of *Petkovsek*. Moreover, the label of *Petkovsek* does not have a color corresponding to one of a plurality of special services for delivery of a mailpiece wherein the color is different for each one of the plurality of special services as required by Claim 1. Therefore, the special service mailing assembly as defined in Claim 1 has novel structural differences and is patentably distinct from the label of *Petkovsek*. Notice to that effect is requested.

With respect to the assertion of the Patent Office that it would be obvious to program the bar coded area of Petkovsek to receive or transmit instructions regarding the delivery of the mailpiece by a special service, Applicant asserts the method for preparing a mailpiece for delivery by a special service as specifically defined in Claim 13 is patentably distinct from the method of Petkovsek. Further, Petkovsek does not have the designation section having an area for receiving instructions regarding the delivery, type of special service and an identifying number of the mailpiece by the special service as required by Claim 13. Therefore, the method for preparing a mailpiece for delivery by a special service as defined in Claim 13 is patentably distinct from Petkovsek. Notice to that effect is requested.

With respect to the rejection of Claims 16-20 under U.S.C. §103(a) as being unpatentable over Walz in view of Popat et al., Applicant respectfully submits that the rejection is improper in view of Claim 16 as previously presented and for the reasons that follow.

In the Office Action, the Patent Office alleges:

Walz discloses in Fig. 1, 4 and 5, an assembly comprising a first form (84) having a first postcard (70), a first anchor portion (58) removably attached to the postcard via a tear line (24), an integrally formed designator section (73) indicative of special services such as restricted delivery which can consist of: certified mail, COD, insured mail, etc. (Col. 4,

lines 45-48), an area (66) contained within the postcard printed with machine readable code (75), and a second form (82) removably attached to the first form by a tear line (20).

However, Walz does not disclose: a second form having a second postcard and a second anchor portion; and a first return postcard having no adhesive.

Popat et al. discloses in Figure 10, an assembly comprising a first form (254a) and a second form (254b), having anchor portions (258, 256, 256c) wherein a tear line (252c) is arranged to separate the first form from the second form.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Walz's assembly to include a multiple form assembly connected by a tear line as taught by Popat et al. for the purpose of printing multiple areas of a sheet without disposing of extra unused paper area and for providing convenience for anyone using an advanced printer.

However, Claim 16 requires a mailing assembly for preparing a mailpiece for delivery by a special service. The mailing assembly for preparing a mailpiece for delivery by a special service requires a first mailing form having a first return postcard and a first anchor portion removably attached to the first return postcard. Additionally, Claim 16 requires a second mailing form having a second return postcard and a second anchor portion removably attached to the second return postcard. Further, Claim 16 requires a first designator section indicative of a special service contained within exterior sides of the first return postcard wherein the first designator identifies the special service as one of registered mail, certified mail, COD, insured mail and return receipt for merchandise.

Contrary to the assertions of the Patent Office, Walz merely teaches a multi-part mailing form for use by businesses in mailing items to various customers or clients and in keeping records of such mailings and is particularly related to forms for use in certain specific types of mailing, such as certified and registered mail procedures. Furthermore, Popat et al. merely teach a multi-purpose sheet assembly that may be divided into subsections and a method for printing the subsections in laser printers, ink jet printers and photocopiers.

Moreover, neither Walz nor Popat et al., taken singly or in combination, teach or suggest a mailing assembly having a second mailing form which has a second return postcard and a second anchor portion removably attached to the second return postcard as required by Claim 16. Additionally, neither Walz nor Popat et al., taken singly or in combination, teach or suggest a mailing assembly having a first designator section indicative of a special service contained within exterior sides of the first return postcard wherein the first designator identifies the special service as one of registered mail, certified mail, COD, insured mail and return receipt for merchandise as required by Claim 16. Therefore, the rejection of Claim 16 under 35 U.S.C. §103(a) is improper and should be withdrawn. Notice to that effect is requested.

Moreover, with respect to the rejection of Claims 16-20 under 35 U.S.C. §103(a), one of ordinary skill in the art would never have been motivated to modify Walz with Popat et al. in the manner suggested by the Patent Office in formulating the rejection of the claims under 35 U.S.C. §103(a). It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's mailing assembly, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of *Walz* and *Popat et al.* in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to modify *Walz* with *Popat et al.* to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

Accordingly, the rejection of Claims 16-20 under 35 U.S.C. §103(a) as obvious over *Walz* in view of *Popat et al.* is improper and should be withdrawn. Notice to that effect is requested.

With respect to the assertion of the Patent Office that it would have been obvious to one having ordinary skill in the art at the time the invention was made to have any desirable indicia in the designator section since it would only depend on the intended use of the assembly and the desired information to be displayed, Applicant asserts that the mailing assembly as specifically defined in Claim 16 has a novel and an unobvious functional relationship as required for patentability. Additionally, Applicant asserts that the Patent Office has improperly construed Claim 16 to include indicia in the designator section. Claim 16 merely requires that the first designator identifies the special service as one of registered mail, certified mail, COD, insured mail and return receipt for

merchandise. Still further, the first designator is not a mere supportive substrate for printed matter. The first designator identifies the special service. Therefore, the mailing assembly as defined in Claim 16 has the novel and unobvious functional relationship that is required for patentability. Notice to that effect is requested.

With respect to the assertion of the Patent Office that only routine skill in the art was involved to include any desirable amount of mailing forms with postcards and anchor portions, Applicant asserts that the mailing assembly as specifically defined in Claim 16 is more than mere duplication of the essential working parts of a device and requires more than ordinary skill in the art. More specifically, Claim 16 requires more than mere mailing forms with postcards and anchor portions. Further, Claim 16 requires a first designator which is indicative of a special service. Therefore, the mailing assembly as defined in Claim 16 having a first designator which is indicative of a special service involved more than only routine skill in the art. Notice to that effect is requested.

With respect to the assertion of the Patent Office that only routine skill in the art was involved to construct the two substrate return postcard as a single substrate postcard, Applicant asserts that the mailing assembly as specifically

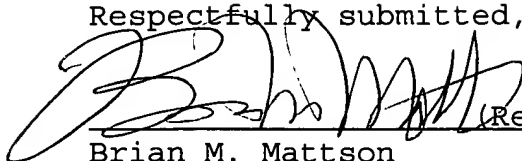
defined in Claim 16 requires more than the mere forming in one piece an article which has formerly been formed in two pieces. Claim 16 requires a first backing strip received over the adhesive on the backside of the first anchor portion and a second backing strip received over the adhesive on the backside of the second anchor portion. Therefore, the constructing of the mail assembly as defined in Claim 16 having a first backing strip and a second backing strip involves more than only routine skill in the art. Notice to that effect is requested.

Claims 2-12 depend from Claim 1; Claims 14 and 15 depend from Claim 13; and Claims 17-20 depend from Claim 16. These claims are further believed allowable over the references of record for the same reasons set forth above with respect to their parent claims since each sets forth additional structural elements and novel steps of Applicant's mailing assembly and method, respectively.

In view of the foregoing remarks, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and

to pass the application to issue.

Respectfully submitted,




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CERTIFICATE OF MAILING

I hereby certify that this **Amendment After Final** is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on August 18, 2003.



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